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EXAMINER

FISHER, MICHAEL J

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/619,542 | Applicant(s) BAYER ET AL. | |
| | Examiner MICHAEL J. FISHER | Art Unit 3689 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/6/10.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-7, 9, 10, 15-33, 40-47, 49-60, 78-94, 138, 139, 141-157 and 226-228 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 1,2,4-7,9,10,15-33,40-47,49-60,78-94,138,139,141-157 and 226-228.

DETAILED ACTION

Double Patenting

Claims 1,2,4-7,9,10,15-33,40-47,49-60,78-94, 138,139,141-157 and 226-228 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 7,113,853. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are both drawn toward checking the title history of a vehicle and are used to check previous owners, while the intended use is different, all the same information is collected and the uses for the collected information are deemed to be obvious variants as the exact same information is gathered and consulted. Allowance of a patent merely for a different intended use would unfairly and improperly extend the period.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1,2,4-7,9,10,15-33,40-47,49-60,78-94, 138,139,141-157 and 226-228 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for a method to be considered a "process" under §101, a claimed process must either: (1) tied to a particular machine or apparatus, or (2) transforms a particular article to a different state or thing. This is called the "machine or-transformation test". In re Bilski, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such a data gathering or outputting, is not sufficient to pass the test.

As to claims 138,139,141-157, the claims recite a computer readable medium without any computer apparatus, as such, they could merely be a signal as there is nothing in the specification precluding such a use.

Claims 1,2,4-7,9,10,15-33,40-47,49-60,78-94, 226-228 are directed toward a computer implement method in which there is merely a trivial use of the computer. The computer merely sends, receives, stores and displays information without any manipulation, all the "determining" could be done by a user merely looking at data on a screen.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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Claims 1,2,4-7,9,10,15-33,40-47,49-60,78-94, 101,102,104-120,138,139,141-157 and 226-228 are rejected under 35 U.S.C. 103(a) as being unpatentable over US PAT 4,989,144 to Barnett, III (Barnett).

As to claims 1, 78,79,101, Barnett discloses identifying records in a database related to a vehicle (title), identifying ownership data (col 7, lines 6-10), identifying a target record based on a title record (abstract, lines 1-2), that is a sale (col 7, lines 9-16). Barnett does not, however, teach using the data to adjust ownership. Barnett does discuss a "salvage" title and further, it is old and well known in the art that a one-owner vehicle is more prized than one which has had multiple owners (for instance, ads that claim "Clean-one-owner!"). Therefore, it would have been obvious to one of ordinary skill in the art to use the method and system as taught by Barnett for adjusting the price of vehicles as a vehicle sold as "salvage" is worth much less than one without, a vehicle with "true mileage unknown" (which would be recorded at a sale) is also worth less and further, a one owner vehicle can be worth more if only by perception.

As to claim 102, there is a user interface with display (fig 1), it can be adapted to display any information contained within the system.

As to claims 10, the target records are flagged in case of transfer (new title).

As to claims 2,80, it is old and well known for used car lots to display the price of the vehicles they're selling, therefore, it would have been obvious to one of ordinary skill in the art to display the price and any mark-downs so a customer can see how much the vehicle costs.

As to claims 81, a dealer accesses the records (fig 1).

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As to claims 4,104, the target record is flagged in case of ownership transfer (col 3, lines 51-57).

As to claims 5, 106, Barnett determines a time between records (table III, col 6).

As to claims 6,9,105, it would be obvious to check the date as a flag as this could indicate an odometer change (for instance, a car is sold at a 10 year interval and only has 1,000 more miles or 100 miles/year).

As to claims 7,30, it would be obvious to check for certain intervals, such as "during the interval when this person owned the vehicle", as this could show discrepancies (the purpose of the Barnett patent).

As to claim 15, Barnett displays the flags (table IV).

As to claim 16,107, Barnett displays and counts ownership transfers (table III).

As to claim 17, it would be obvious to determine a price change in order to be able to decide on a selling price for the vehicle.

As to claim 18, as discussed, it is obvious to charge more for a one-owner vehicle, therefore, it would be obvious to charge less for a vehicle with more than one owner and more for one with more owners.

As to claim 19,108, the third party is the state.

As to claims 20, the interval is deemed a matter of obvious, engineering design choice and would not render the instant application patentably distinct. The examiner will note that the time difference mentioned is 60 days (col 8, lines 25-50).

As to claim 125, regions are shown (table III).

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As to claim 90,91, as discussed, it is obvious to charge more for a one-owner vehicle, therefore, it would be obvious to charge less for a vehicle with more than one owner.

As to claim 109,110,111, region information and sale information is recorded (table III).

As to claim 112, the system would show a first ownership (the first person to which the vehicle was titled).

As to claim 21, the organization is recorded (table III).

As to claims 22, these are well known organizations that sell cars and would not render the instant application patentably distinct.

As to claims 23, 113, the interval is deemed a matter of obvious, engineering design choice and would not render the instant application patentably distinct.

As to claims 24, a "salvage" would include a service plan record.

As to claims 25, the interval is deemed a matter of obvious, engineering design choice and would not render the instant application patentably distinct.

As to claims 26, the "dealer usage record" would be the sale.

As to claims 27, the interval is deemed a matter of obvious, engineering design choice and would not render the instant application patentably distinct.

As to claim 28, the signing of the title for sale is considered to be "a user confirmation".

As to claim 29,82, the user "questionnaire" would be the request for the information.

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As to claim 31, the record is a dealer record (table III).

As to claims 32, 83, it is old and well known to store information on a database, therefore, it would have been obvious to one of ordinary skill in the art to store data on a database to ensure it is saved.

As to claims 84, it would be obvious to use a registration as these also record transaction information.

As to claims 33, the length of the interval is deemed a matter of obvious, engineering design choice and would not render the instant application patentably distinct.

As to claim 40,115, it would be obvious to determine if the user was the first owner so as to know if it is a one-owner vehicle.

As to claims 41-43, the length of the interval is deemed a matter of obvious, engineering design choice and would not render the instant application patentably distinct.

As to claim 44,114, it would be obvious to use a predetermined mileage to determine if the owner was the first (for instance, less than 10 miles as a new car generally has very few miles on it), the exact mileage would be a matter of obvious, engineering design choice and would not render the instant invention patentably distinct.

As to claims 45,46, the interval is deemed a matter of obvious, engineering design choice and would not render the instant application patentably distinct.

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As to claim 47, it would be obvious to determine and display if the user was the first owner so as to know if it is a one-owner vehicle.

As to claim 49,116, as discussed, it is obvious to charge more for a one-owner vehicle, therefore, it would be obvious to charge less for a vehicle where the number of owners is unknown and therefore, could not be promised as a "one-owner" vehicle.

As to claims 50, as discussed, it is obvious to charge more for a one-owner vehicle, therefore, it would be obvious to charge less for a vehicle with more than one owner.

As to claims 51 and 52,117, 118,119,120, it is old and well known to decide vehicle costs based on make, model, year, published value, therefore, it would have been obvious to use these factors as otherwise, a 2002 Hyundai with 200,000 miles could have the same asking price as a 2008 Mercedes convertible with 5,000 miles. Further, for claim 117 and 120, Blue Books adjust prices based on actual sales, thereby meeting the limitations as claimed.

As to claims 226,227 and 228, the determining step is where the price is "determined", thereby meeting the limitations as claimed.

As to claim 53, it is old and well known to base cost on age of vehicle, therefore, it would have been obvious to use these factors as otherwise, a 2008 Mercedes convertible with 200,000 miles could have the same asking price as a 2008 Mercedes convertible with 5,000 miles.

As to claim 54, it is obvious to use a well known item such as a "blue book" for its intended task.

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As to claim 55, it is obvious to use the price range supplied from a "blue book" in setting prices, such as "clean price" or "high mileage price", et al.

As to claims 56,60, it is obvious to base a price on a category of the vehicle, for instance, when gas prices are high, vehicle with low gas mileage are cheaper while those with high gas mileage are more desirable and therefore, more expensive.

As to claims 57, it would be obvious to base price on ownership time and mileage patterns (for instance, a 40 year old car with 80,000 miles would be more desirable than a 40 year old car with 800,000 miles).

As to claims 58, as discussed, it is obvious to charge more for a one-owner vehicle.

As to claims 59, the number of owners is displayed (table III).

Response to Arguments

Applicant's arguments filed 4/6/10 have been fully considered but they are not persuasive. As to arguments in relation to the rejection under double patenting, the rejection stands, applicant is merely using the same data in a different manner, the manner being an obvious variant as knowing the number of owners of a vehicle is old and well in the art (one owner vehicles being prized, ads routinely note "Clean one-owner!!!!"), as to arguments in relation to the rejection under 35 U.S.C. 101, the rejection has been further clarified. Using the computer to "identify" records could be merely using the computer screen to see the records and thereby "identify" them. As to arguments in relation to the rejection concerning the computer readable medium being

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merely a signal, the rejection stands as there is nothing in the specification that precludes such a "medium". As to arguments in relation to ownership transfer, as knowing the number of owners of a vehicle is old and well known in the art to be useful as applicant has not disputed this, it is admitted prior art, therefore, it would be obvious to use data collected to ascertain this information. There would definitely be a reasonable expectation of success when using ownership data to check for previous owners.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL J. FISHER whose telephone number is (571)272-6804. The examiner can normally be reached on Mon.-Fri. 7:30am-5:00pm alt Fri. off.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael J Fisher/

Examiner, Art Unit 3689

MF

7/6/10